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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,967	12/07/2001	Dan L. Eaton	P1447R1	9428

9157 7590 03/23/2005

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EXAMINER	
JIANG, DONG	
ART UNIT	**PAPER NUMBER**
1646	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/015,967	**Applicant(s)** EATON ET AL.	
	Examiner Dong Jiang	**Art Unit** 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on *8/19/04*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): Scope rejection, and lack of written description rejection of claims 33-37 under 35 U.S.C. 112, first paragraph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *33-43*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Item 7 (continue): Claims 33-42 remain rejected under 35 U.S.C. 102(b) as being anticipated by Lal et al., WO 200000610-A2 (06 Jan.-2000), for the reasons set forth in the previous Office Actions mailed on 6/6/03, and 4/6/04. Applicants argument filed on 15 February 2005, has been fully considered, but is not deemed persuasive for reasons below. At page 5 of the response, Applicants repeat the argument in the last response to the final Office Action that the Examiner's position appears to be that by merely naming a polypeptide sequence, and without informaiton regarding biological role, function or acitivity of the polypeptide that would enable one of skill in the art to use the polypeptide sequence in any manner, the Lal reference anticipates the presently claimed polypeptide. Applicants argument has been fully considered, but is not deemed persuasive because, as addressed in the last advisory action, it is not the Examiner's position, rather, it is that the statute of 102(b) itself merely requires that "the invention was patented or described in ...", i.e., in order to be qualified as 102(b) art, a reference only needs to teach how to "make" the product, but not necessarily how to "use". The present invention is directed to a product, an isolated polypeptide, which sequence was disclosed in the prior art reference. Therefor, the invention was described in the prior art reference, and it has taught one skilled in the art how to make the polypeptide by following the sequence disclosed. As such, whether the Lal reference provides any information regarding biological role, function or activity of the polypeptide is irrelevant with respect to the rejection, and it does not affect the reference being anticipating art for the rejection of the present claims under 35 U.S.C. 102(b).

Applicants further argue, at pages 5-7 that applicants explanations of the scientific deficiencies of the Lal reference have not been contested by the Examiner, as majority of the reference is not specific to the relevant polypeptide of SEQ ID NO:94, which renders it legally insufficient to anticipate the claims, and that if a printed publication fails to enable one skilled in the art to carry an invention into practical use, it cannot be a bar to patenting under 35 U.S.C. 102(b). Applicants argument has been fully considered, but is not deemed persuasive because whether the prior art teaches other things is irrelevant so long as it teaches what in the claims. Further, as addressed above, the statute of 102(b) itself merely requires that "the invention was patented or described in ...", and MPEP (§2122) states, in "Discussion of Utility in the Prior Art", that utility need not be disclosed in reference, and that in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility need be disclosed by the reference. In re Schoenwald, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992). Therefore, the Lal reference remains anticipating the present claims.

Furthermore, claim 43 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Lal et al., WO 200000610-A2 (06 Jan.-2000) as applied to claims 33-42 above, and further in view of Capon et al. (US 5,116,964), for the reasons set forth in the previous Office Actions, and the reasons above.

Elizabeth C. Kemmerer